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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/621,234    07/20/00    HENSHAW

W    ZEN-9501-A-R

EXAMINER

IM22/1002

LOBO & CO LPA  
933 THE LEADER BLDG  
526 SUPERIOR AVE  
CLEVELAND OH 44114-1401

FORTUNA, A

ART UNIT

PAPER NUMBER

10

1723  
DATE MAILED:

10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/621,234

Applicant(s)

Henshaw et al.

Examiner

Ana Fortuna

Art Unit

1723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Apr 2, 2001

2b) ☒ This action is non-final.

2a) ☐ This action is FINAL.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 1-14 is/are allowed.

6) ☒ Claim(s) 15-18 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Application/Control Number: 09/621,234

Art Unit: 1723

Claims 15-18 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application (08/690,045) for the patent (US 5,783,083) upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 1 and 9 in 08/690,045, now US 5,783,083, both have the following proviso:

the improvement comprising:  
each said header having said fibers spaced apart by a flexible support means having a thickness corresponding to a desired lateral spacing between adjacent fibers, said support means extending over only each terminal portion of said fibers near their ends, so as to maintain said ends in closely-spaced apart relationship.

The proviso was added by amendment on January 12, 1998, paper no. 4, along with extensive argument of how the newly added limitation distinguishes the claimed invention over the prior art cited by the examiner. At p. 7 of that amendment, for instance, the applicants refer to the "flexible support means having a thickness corresponding to a desired lateral spacing between

Application/Control Number: 09/621,234

Art Unit: 1723

adjacent fibers" as the "second essential element" which gave their invention a clear advantage over the prior art.

The record is clear, therefore, that the applicants surrendered broader coverage when they added the proviso to their claims in order to obtain a patent. Claims 15-18 in this reissue lack that limitation and thus they are rejected under 35 USC 251 as involving an improper attempt to recapture surrendered subject matter. See MPEP 1412.02.

It is noted that claim 15 in this reissue includes limitations about a pump which apparently was not recited in claims 1 and 9 of 08/690,045, now US 5,783,083. Nevertheless, claims 15-18 in this reissue are missing the aforementioned proviso which was "an aspect germane to a prior art rejection." See MPEP 1412.02, subheading "Reissue claims are broader in scope in some aspects, but narrower in others".

Application/Control Number: 09/621,234

Art Unit: 1723

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for regular responses, and (703)872-9311 for after finals.

Ana Fortuna

October 1, 2001

  
ANA FORTUNA  
PRIMARY EXAMINER